

Appl. No. 10/034,002
Amdt. dated December 9, 2004
Reply to Office Action, date mailed Sept. 9, 2004

REMARKS

Claims 1-20 are pending in the application.

Claims 1-17, 19 and 20 have been rejected.

Claim 18 has been objected to.

1. Rejections under 35 USC § 102

Claims 1, 3-15 and 16 were rejected under 35 U.S.C § 102(e) as being anticipated by U.S. Patent No. 5,852,775 to Hidary (hereinafter "Hidary").

The official action states:

With respect to claim 1, Hidary discloses central office switch, or mobile terminal switching office ("MSTO") 12, which inherently includes a processor that requires memory to store computer instructions for the processor to fetch and execute. The MSTO's processor executes computer instructions sufficient to receive user identification ("ID") and cell location from the mobile telephone user by relying on a subscriber identifier 52 and subscriber locator (a.k.a. cell ID) 54, which in an alternate embodiment are part of (and thus received from) the master station (col. 3, lines 7-17). The user ID corresponds to the number assignment module ("NAM") of the user's mobile phone (Fig. 1, memory bank 22 and col. 2, line 23-34) and thus can be considered a mobile terminal ID. This profile information is received when the subscriber 16 registers his presence (requests an open channel) (col. 2, lines 48-67). The profile information is used to search for related profile information stored in the subscriber profiles 58 of the external, ad server's memory bank 26 (Figs. 1 and 2) in order to determine what ad to push from ad message memory 60, 62, 64, and 66 to the subscriber's mobile terminal (Fig. 2 and col. 3, lines 4-17). A data bus would inherently be required between the MSTO's processor and memory in order for the processor to fetch instructions from, similar to the computer bus 56 illustrated between the ad server's processor and memory (Fig. 2).<emphasis added>

Claim 1 is amended to require the push adds to be transmitted (sent) by the information server based upon "at least one an identified Picocell wherein push adds are arranged according to Picocell service areas or based upon specified products and services identified in a user profile associated with the mobile terminal ID."

As the Official Action observes, Hidary does not disclose Picocells. The Official Action relies on Buhrmann for a teaching of Picocells. Buhrmann does not teach,

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however, arranging push adds according to Picocell service areas (for example, areas that are limited to about a 60 foot radius as defined in the present application). Given the dramatic size difference between cells (which may cover many square miles) and Picocells (which may cover an area substantially smaller than a football field), the effort required to arrange adds for products and services by Picocell area is substantial and is conceptually very different from arranging such adds by the much larger cell areas. Thus, the Applicants disagree that combining these teachings teaches or suggests the invention as claimed in the claims as amended herein.

As an additional consideration, Hidary is cited (col. 3, lines 18-24) to illustrate using subscriber profiles to determine what types of push adds are to be sent to user. Hidary specifically states that the subscriber information "may include age, sex, income, hobbies, preferences, profession and other similar information." The Applicants note that these types of information are general and largely static though each can occasionally change. Hidary does not suggest, however, that a system be employed to support entry of specific products or services (presumably on a more dynamic basis). Thus, Hidary does not teach sending push adds, perhaps on a Picocell or WLAN service area basis, for specified products (in contrast to general data or interests). Thus, the Applicants believe that Hidary and Burhmann also do not render the claimed invention obvious for the reasons stated as there are no suggestions to employ the present teachings.

The Official Action further states:

Claim 11 differs substantively from claim 1 in that claim 11 recites a method for performing steps equivalent to the server components recited in claim 1. Therefore, see the claim 1 rejection for additional details. In addition, claim 11 recites that customer profile information is transmitted to an external server in order to receive the push data. As discussed in the claim 1 rejection above, Hidary discloses that customer profile data (mobile terminal ID and user's cellular location) are transmitted to ad server 24 in order to receive the push ads (if appropriate), which is illustrated as an external server (Fig. 1).

As amended, claim 11 includes the above discussed claim language of claim 1 and is thus considered by the Applicants to overcome the rejection for the same reasons.

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2. Rejections under 35 USC § 103

Claims 19 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary as applied to claim 11 above, and further in view of U.S. Patent Application Publication No. 5,950,125 to Buhrmann et al. ("Buhrmann"). Claim 19 is amended to specify a Picocell or "wireless local area network" within which the mobile terminal is being serviced.

In addition to the points above that Buhrmann and Hidary, in combination do not teach the claimed invention, and as was stated above, the Applicants do not agree that with the Official Action the teachings of Hidary to be applied to the teachings of Buhrmann. First, Hidary deals to a service of delivering advertisements. Buhrmann deals with telephone network topologies and traditional telephone services (Buhrmann uses the example of call forwarding). Buhrmann further suggests that different rate structures for the wireless phone apply to different service zones. While Buhrmann lists picocells as well as cells, Buhrmann appears to be more concerned with the concept of zones and having differing rates structures therefor. Buhrmann thus seems to be concerned with an entirely different problem than is Hidary or the current Applicants. Thus, the Applicants do not believe that Buhrmann is analogous art and do not believe that the combination of Hidary and Buhrmann is appropriate.

The Applicants do not therefore believe that a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, has been shown to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success for the combination. Given that it is a huge undertaking to associate push adds by the very small geographic areas defined by Picocells, it cannot be taken for granted that such an approach would be either successful or even desirable (given the potential magnitude of such an undertaking). Finally, the references do not teach or suggest all the claim limitations as discussed above. The teaching or suggestion to make the claimed combination and the reasonable

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expectation of success must both be found in the cited references, and not based on applicant's disclosure. MPEP 2143, p. 2100-121 (August 2001).

3. Allowable Subject Matter

Claim 18 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicants greatly appreciate the indication of allowability.

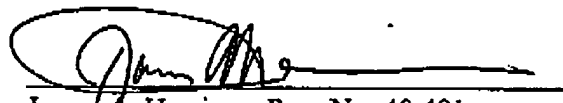
4. Conclusion

The two independent claims are amended therefore rendering the grounds for rejection moot. Nonetheless, the Applicant has addressed some of the grounds of rejection in relation to the amended claims to further the process. As a result of the foregoing, the Applicant respectfully requests an early allowance of the pending claims.

If any issues arise, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at jharrison@texaspatents.com. The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 502126.

Respectfully submitted,

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